PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jesus PRIETO VALTUENA, et al
Serial No.: 09/674,445 Group No.: 1614
Filed: November 1, 2000 Examiner.: Robert S. Landsman
For: UTILIZATION OF INTERFERON ALPHA 5 IN THE TREATMENT OF VIRAL HEPATOPATHIES

#9
6/17/02

Attorney Docket No.: U 013039-2

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Official Action of March 15, 2002 wherein the Examiner has required restriction between inventions, Applicants hereby elect to prosecute the invention of Group I with traverse. This election is made with traverse insofar as this application is a national stage entry of a PCT application and, as such, PCT unity of

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CERTIFICATE OF MAILING (37 CFR 1.8a)

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invention rules apply (see MPEP Sections 801 and 1850). By contrast, the present restriction requirement impermissibly applies US restriction practice to this national stage application.

Unity of invention is satisfied under PCT rules where there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features (see PCT Rule 13.2). The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. In the present case, there is a technical relationship among the claimed inventions involving the same or corresponding special technical features, namely the determination/regulation of IFN-alpha 5 levels in the liver of a patient to screen for or treat liver disease.

It is respectfully submitted that, under PCT rules, an election as required by the Examiner cannot be made where, as here, there is an absence of prior art that shows the invention as broadly claimed. Under applicable PCT rules, unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims (see MPEP Section 1850). As discussed in MPEP Section 1850, if the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem

arises in the case of a genus/species situation where the genus claim avoids the prior art.

In view of the above, and in the absence of anything to suggest that the independent claims do not avoid the prior art, it is respectfully submitted that there is no basis for a restriction requirement in the present application. Accordingly, Applicants respectfully request withdrawal of the restriction requirement and an early examination on the merits of all claims.

Respectfully submitted,

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